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| SERIAL NUMBER | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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07/702,938 05/20/91 CAMPANA

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DEKLING EXAMINER

26ML/0825

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ART UNIT PAPER NUMBER

-2608

23

DATE MAILED: 08/25/94

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 5-23-94 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s),        days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133.

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- |   |   |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449.                 | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.       |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.     | 6. <input type="checkbox"/> _____   |

Part II SUMMARY OF ACTION

1. ☒ Claims 24-86 are pending in the application.  
Of the above, claims 86 are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☐ Claims \_\_\_\_\_ are allowed.
4. ☒ Claims 24-85 are rejected.
5. ☐ Claims \_\_\_\_\_ are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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1. Newly submitted claim 86 is directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 86 is drawn to a method of transferring information from an RF receiver to a processor wherein claims 24-85 are drawn to a system and method of transferring electronic mail between different electronic mail systems. Claims 24-85 are not directed to the particular details of transferring information from the RF receiver to the destination processor, and further, the method as set forth by claim 86 has separate utility in other applications than those of electronic mail systems. Therefore, claim 86 is distinct from claims 24-85 and thus would require a further search.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 86 is withdrawn from consideration as being directed to a non-elected invention. See 37 C.F.R. § 1.142(b) and M.P.E.P. § 821.03.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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3. Claims 24 and 45 are rejected under 35 U.S.C. § 102(b) as being anticipated by Zabarsky et al.

Consider claims 24 and 45. Zabarsky et al. disclose in figures 1, 2, and 6 a system for connecting a plurality of electronic mail systems (100, 600, and 602) which transmit originated information from an originating processor (104, 106, or 108) to a destination processor (106). The system comprises at least one interface switch (integration of the paging executive 212 and data packet switch 214, note col. 5, lines 34-38), which is coupled to each of the plurality of e-mail systems, for receiving originated information from an originating processor in one e-mail system and transmitting the information to a destination processor in another e-mail system. It should be noted that transmission amongst the e-mail system can be hard-wire (606) as opposed to a radio link (608). The system further comprises an RF transmission network (NCP 204 and base transceivers 200-202), coupled to the interface switch, for transmitting the originated information received from the interface switch to an RF receiver (1025) within the destination processor (106) which resides in the other e-mail system.

4. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that

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the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

5. Claims 25-44 and 46-85 are rejected under 35 U.S.C. § 103 as being unpatentable over Zabarsky et al.

Consider claims 25 and 46. Zabarsky et al. disclose that the address of the destination processor is added to the originated information by the originating processor (note fig. 11, step 1114). In col. 15, lines 48-61, Zabarsky et al. disclose that if the destination processor resides within another (distant) e-mail system, the "routing information" necessary to send the originated information to the interface switch (212,214) of the distant e-mail system is obtained. Zabarsky et al. differ from claims 25 and 46 of the present invention in that they do not specifically state that the address of the interface switch is added to the originated information. However, it would have been at least obvious, if not inherent, to add the address of the interface switch (distant PEX) to the originated information such that the information is properly routed to and received by the destination processor in the distant e-mail system.

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Consider claims 26, 28, 30, 47, and 49. Zabarsky et al. disclose that once the distant PEX receives the originated information from the PEX where the originating processor resides, routing information regarding the NCP and base transceiver of the RF transmission network is used to route the message to the destination processor. Note col. 6, lines 54-61. Although not disclosed by Zabarsky et al., it is well known in the art when routing a message from an origination point to a destination point, to remove previously used addresses and add new addresses of intervening points between the origination and destination points. It would have been obvious to one of ordinary skill in the art to implement this known technique in Zabarsky et al. such that addresses which are no longer required for routing of the message are deleted from the message, thereby reducing the size of the transmitted message.

Consider claims 27, 29, 31, 48, and 50. Zabarsky et al. disclose that the address of the destination processor contains a 4-digit identification number of the RF receiver (contained within the destination processor) which is used by the destination processor to identify messages for itself. Zabarsky et al. further disclose that this identification is input at the originating processor (note, fig. 11, step 1114). Although, Zabarsky et al. disclose the identification of the RF receiver to be added at the originating processor, as was previously

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discussed above, it would have been obvious to add the identification of the RF receiver at any intermediate point before the RF receiver lacking any criticality or showing by applicant since this identification information would not be necessary until the point in the route just prior to the RF receiver.

Consider claims 32-43 and 51-60. The address of the destination processor is an identification number of the RF receiver which is contained within the destination processor. Further, although Zabarsky et al. do not specifically disclose that the interface switch assembles the originated information into a packet for transmission to the RF transmission network (NCP and base transceivers), data packet transmission is very well known in the art, as evidenced by Zabarsky et al. which transmits data packets amongst the data packet switches (214) between the different systems (100, 600, and 602). It is also well known that once the data packet is received at a destination point, to disassemble the packet and route each of the plurality of data to its particular destination (evidence has already been provided in the record). Since Zabarsky et al.'s system has multiple users, it would have been obvious to one of ordinary skill in the art to use the well known packet transmission technique between the interface switch and RF transmission

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network to efficiently transmit the plurality of originated information corresponding to the different users of the system.

Consider claims 44 and 61. As discussed previously, with the modification to Zabarsky et al., the address of the interface switch is added to the originated information to properly route the information to the destination processor associated with the distant PEX. Although, Zabarsky et al. do not disclose that the address of the interface switch is added to the originated information by the originating processor, the point at which the address of the interface switch is added lacks criticality providing that it is added prior to the interface switch in the hierarchial routing structure of the system. Thus, it would have been obvious to add the interface switch address at the originating processor or at any other point in the route prior to the particular interface switch lacking any criticality or showing by applicant since this information would not be necessary until the point in the route just prior to the interface switch.

Consider claim 62. Zabarsky et al. disclose that the originated information can be stored at the RF receiver/destination processor.

Consider claim 63 and 64. The RF receiver and destination processor, as depicted in figure 10, are portable.

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Consider claims 65-67. At the bridge of cols. 4 and 5, Zabarsky et al. disclose that the RF receiver can be separate from the destination processor. Further, it is inherent that the destination processor cannot receive the information until the RF receiver is coupled to the destination processor since the information is being transmitted via RF.

Consider claims 68 and 69. It would have been at least obvious, if not inherent, to include the necessary software to transfer the originated information to the destination processor such that the information is accessible to the user.

Consider claims 70-85. The transmission of the originated information from the originating processor to the interface switch is through a computer, modem, a public telephone network, and gateway switch when the originating processor is the external terminal (104). Further, private branch exchanges (PABX) and local area networks (LAN) are very well known communication systems and would have been obvious to include in the routing of the originated information to the destination processor if such networks are utilized by a user who is receiving the originated information.

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The article "X.400 Breeds Third-Generation E-mail Systems", TPT (3-1989), vol. 7, no. 3, p. 34-7, by J. Morris is cited as



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evidence that, in a broad interpretation, the definition of an electronic mail system encompasses communicating in a radio paging system.

The following articles disclose transmission of electronic mail via radio:

a) "Data Communications on Cellular - The Office of Tomorrow in Your Car Today.", What Telephone and Communication News (10-1985), no. 14, p. 28-31.

b) "Cellular Radio", Computer Law and Security Report (1-1986), vol. 1, no. 5, p. 18-19.

c) "More Power to the Pager", Today's Office (7-1987), no.7, p.16-17.

d) "Get Me Memphis Tennessee (Cellular Communications)", Micro Decision (5-1989), no.95, p.50-4.

e) "Tele-Laptop: Mobility As Deciding Competition Feature (RadioTelephone and Computer)", Funkschau (12-1989), no.26, p.35-6, 39.

f) "Electronic Mail Radio Pulse Shaper...", Revue Polytechnique (12-1989), no. 12, p. 1508-10.

7. Applicant's arguments with respect to claims 1-23 have been considered but are deemed to be moot in view of the new grounds of rejection.

8. Applicant's amendment necessitated the new grounds of rejection. Accordingly, **THIS ACTION IS MADE FINAL.** See M.P.E.P.

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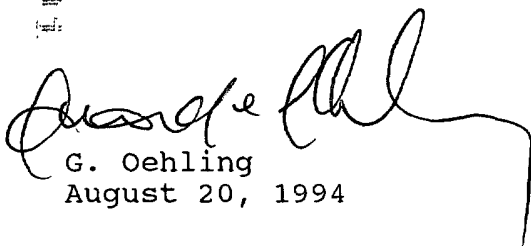
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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to George Oehling whose telephone number is (703) 305-4835.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-4700.

  
G. Oehling  
August 20, 1994

  
CURTIS KUNTZ  
SUPERVISORY PATENT EXAMINER  
GROUP 2608